

REMARKS

The Examiner has allowed claims 1-22; rejected claims 37-45 under 35 U.S.C. § 102(b); and rejected claims 32-35, 38-43, 46, and 47 under 35 U.S.C. § 103(a). Each of these rejections is discussed separately below. No amendments have been made to the claims.

§ 102(a) REJECTIONS

The Examiner has rejected claims 37 and 45 under § 102(b) as being anticipated by Grove U.S. Patent No. 4,004,262. This rejection is traversed for the reasons set forth below.

Anticipation requires the presence in a single prior art reference disclosure, each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). While certain results or characteristics may be inherent in a disclosure and still anticipated, the fact that a certain result or characteristic *may* occur or *may* be present in prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *In re Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990). In proceedings before the U.S. Patent & Trademark Office, the Examiner bears the burden of establishing a prima facie case of anticipation based upon the prior art. *In re Sun*, 31 U.S.P.Q.2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Applicant respectfully asserts that the Examiner has not met his burden of establishing a prima facie case of anticipation with respect to the rejected claims.

With regard to claim 37, the Examiner states that (1) the electromagnet of Grove '262 has a magnetic cross section that is constant to within plus or minus three percent, and (2) the moldable material of the Grove '262 electromagnet comprises a donor material with an elasticity greater than about 2 million psi, referencing Lexnan, epoxy, polyurethane, and a natural or synthetic rubber. The Examiner cites Fig. 2 of Grove '262 as a disclosure that the magnetic cross section is constant to within plus or minus three percent. Fig. 2 of Grove '262 in no way discloses such a feature. Also, the Examiner has provided no support for the assertion that the general disclosure by Grove '262 of moldable material *necessarily* discloses that the electromagnet has an impregnated powder metal core with a donor material having elasticity greater than about 2 million psi. Moreover, there is nothing in the Grove '262 reference that even suggests this characteristic. Thus, the Examiner has not made a showing of a prima facie case of anticipation of claim 37.

As to claim 45, the Examiner states that the moldable material of the Grove '262 electromagnet comprises a donor material with an elasticity greater than about 2 million psi, again referencing Lexnan, epoxy, polyurethane, and a natural or synthetic rubber. Again, the Examiner has provided no evidence or support of any kind that demonstrates that the disclosure of those general materials necessarily discloses a donor material with an elasticity greater than about 2 million psi. The Examiner has not made a prima facie showing of anticipation and the Applicant respectfully requests that the § 102(b) rejections be withdrawn.

§ 103 REJECTIONS

The Examiner has rejected claims 32-35, 38-43, 46, and 47 under § 103(a) as being unpatentable over Grove U.S. Patent No. 4,004,262. In order to establish a prima facie case of obviousness, the Examiner, among other things, must show that the prior art reference or references teach or suggest all of the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The burden is on the Examiner to make this showing. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). Applicant respectfully submits that the Examiner has not met his burden of establishing a prima facie case of obviousness with respect to the rejected claims.

Claims 32-35 recite an electromagnet assembly comprising, among other things, friction material comprising a polymeric donor material and a powder metal housing having a rim with a thickness of between about 0.127 and 0.400 inches. The Examiner states that it would have been obvious to adjust the thickness of the rim of the housing of Grove '262. First, although Grove '262 does disclose an electromagnet having a friction member which may or may not comprise a plastic, there is no indication that the friction material is a donor material in the way that term is used in the present application. Second, the Examiner has not pointed to any disclosure that, and, in fact, Grove '262 does not provide any suggestion that, the rim of the Grove '262 electromagnet should be modified to discover a "optimum or workable range" for the thickness. This apparently was not even considered by Grove and, therefore, it would not have been obvious to one of ordinary skill in the art based on the Grove '262 disclosure.

As to claims 38 and 39, these claims recite a metal core having a Young's modulus of between about 6.8 million psi and about 29.5 million psi. In the same regard, claims 40-43 and

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46-47 recite a specific yield strength range. Apparently, Grove did not even consider the Young's modulus or yield strength characteristics of the electromagnetic core as they are not discussed in the Grove '262 patent. Thus, one of ordinary skill in the art reading the Grove '262 patent would not have found it obvious to find an optimum value of these characteristics by reading the Grove '262 reference. Grove '262 provides no motivation or suggestion regarding these characteristics, and therefore it would not have been obvious based on the Grove '262 patent for one of ordinary skill in the art to even consider these characteristics, let alone find the "optimal" ranges for these characteristics.

The Grove '262 reference does not disclose or even suggest all of the elements of the rejected claims and, therefore, the § 103 rejections are improper. Applicant respectfully requests that they be withdrawn.

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CONCLUSION

It is believed that the above represents a complete response to the official Office Action.
Applicant respectfully submits that the application is in condition for allowance and respectfully
requests a notice of allowance.

Respectfully submitted,

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